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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/202,758      | 12/21/1998  | GARY ANTHONY JUBB    | M8540/185343        | 3326             |

7590 10/06/2003

JOHN S PRATT  
KILPATRICK & STOCKTON  
1100 PEACHTREE STREET  
SUITE 2800  
ATLANTA, GA 30309-4530

EXAMINER

GROUP, KARL E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1755     |              |

DATE MAILED: 10/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/202,758

Applicant(s)

JUBB ET AL.

Examiner

Karl E Group

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 August 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 24.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Information Disclosure Statement***

1. US patent document 5,997,315 to Akama et al has not been considered since the Patent does not pertain to the instant invention. A copy of GB 2259700 was not received and therefor was not considered.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10 and 12 stand rejected for falling outside the scope of claim 8 and therefor not further limiting. Both the boron oxide and phosphorous oxide are optional. Changing the claim language of claims 10 and 12 to "one or both" such as set forth in claim 14 will overcome this rejection.

***Claim Rejections - 35 USC § 102***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 8-15 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Jensen et al (5,691,255; 5,614,449; WO 95/29135) each taken alone, for reasons of record.

Applicants argue that some of the examples of Jensen et al fall outside the expressions set forth in claim 8. It is agreed that some of the examples do fall outside the expressions, however examples 1A,2,2A and 4A fall squarely within the parameters set forth in claim 8. In reference to the claimed properties, products of identical composition may not have mutually exclusive properties. In re Spada, 15 USPQ2d 1655,1658 (Fed. Circ. 1990).

6. Claims 8,9 are rejected under 35 U.S.C. 102(b) as being anticipated by Thelohan et al (RE. 35,557 and 5,250,488), each taken alone for reasons of record.

Applicants argue that Thelohan et al fail to teach refractory fibers. This is not persuasive because Thelohan et al teach the claimed method of adding  $B_2O_3$  and/or  $P_2O_5$  as set forth in the claims. The term "refractory" does not distinguish over the fiber of Thelohan et al because Thelohan et al teach heat insulation, which would require some refractoriness of the fiber.

7. Claims 8-15 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Karppinen et al (US 5,843,854 and WO 92/09536), each taken alone, for reasons of record.

Applicants argue that Karppinen et al is not concerned with insulating a furnace or kiln. This is not persuasive because the claims are not claiming a method of insulating a furnace or kiln, as well as the disclosure is silent as to such applications. Secondly the instant claims, as the only active process step have adding  $B_2O_3$  and/or  $P_2O_5$ , which is met by Karppinen et al. As to the product claims

products of identical composition may not have mutually exclusive properties. In re Spada, 15 USPQ2d 1655,1658 (Fed. Circ. 1990).

8. Claims 8-15 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Holstein et al (US 6,060,414; 6,037,284 and WO 93/22251), each taken alone, for reasons of record.

It is maintained that Holstein et al teach all the active process steps in the instant claims. Furthermore products of identical composition may not have mutually exclusive properties. In re Spada, 15 USPQ2d 1655,1658 (Fed. Circ. 1990). It cannot be seen how fibers of the prior art having compositions within the ranges of the instant claims may have different properties.

### ***Conclusion***


9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl E Group whose telephone number is 703-308-3821. The examiner can normally be reached on M-F (6:30-4:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 703-308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Karl E Group  
Primary Examiner  
Art Unit 1755

keg  
10-01-03